IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re the Patent Application of

Steven R. Boal

Application No. **09/451,160**

Filed: November 30, 1999

For: ELECTRONIC COUPON DISTRIBUTION SYSTEM

Art Unit: **3622**

Examiner: D. Champagne

SUPPLEMENTAL APPEAL BRIEF

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is a Supplemental Appeal Brief, submitted under 37 C.F.R. §§ 1.192 and 1.193(b)(2)(ii), requesting reinstatement of the Appeal in response to the rejection of the Examiner made within the non-final Office Action of July 13, 2003 (Paper No. 27) reopening prosecution of this case. Each of the topics required by Rule 192 is presented herewith and is labeled appropriately.

I. Real Party In Interest

Coupons, Inc. of Palo Alto, California ("Coupons") is the real party in interest of the present application.

An assignment of all rights in the present application to Xadvantage Corporation was executed by the inventor and recorded by the U.S. Patent and Trademark Office at **reel 010543, frame 0709.**

An assignment of all rights in the present application to COUPONS.COM, Inc. was executed by Xadvantage Corporation and recorded by the U.S. Patent and Trademark Office at **reel 010820, frame 0891.**

An assignment of all rights in the present application to Coupons was executed by COUPONS.COM, Inc. and recorded by the U.S. Patent and Trademark Office at **reel 012544, frame 0069.**

II. Related Appeals And Interferences

There are no appeals or interferences related to the present application of which Appellant is aware.

III. Status of Claims

Claims 1-25 were originally filed and are pending in this application.

By the amendment of July 18, 2002, claims 19-21 were canceled.

By the amendment of December 20, 2002, claims 26-46 were added.

Within the Amendment After Final Rejection Under 37 C.F.R. § 1.116 submitted concurrently on March 19, 2003, claims 26, 28-31, 42, 44 and 46 have been amended.

Accordingly, appellant hereby appeals the rejection of claims 1-18 and 22-46, which are presented in the Appendix.

IV.   Status of Amendments

No amendments have been made subsequent to the non-final rejection of July 31, 2003.

V. Summary of the Invention

The present invention relates generally to a system and method for coupon distribution, and, more particularly, to an electronic coupon distribution system.

Figure 1 of the specification as originally filed depicts a system 10 that includes a client system 14. Device ID is depicted within figure 1 as USER ID 30. The user ID does not specifically identify the user personally, but rather, more accurately associates a physical machine defining client system 14 with user profile information obtained during registration (page 10, lines

9-12). Main server system 12 can correlate the provided user ID 30 with user information (page 10, lines 15-16).

Figure 4 of the specification as originally filed depicts step 107. Within that step, personal information such as the user's name, e-mail address, residence address, social security number, telephone number, and the like are not obtained (page 19, lines 34-36). The user ID does not specifically identify the user personally, but rather, more accurately associates a physical machine defining client system 14 with user profile information obtained during registration (page 10, lines 9-12).

Significantly, however, the user is not personally identified nor is it even possible (e.g., through the "hacking" of server system 12) to identify the user personally, as such information is not even collected from the user (page 10, lines 19-22).

Page 17, lines 21-28 of the specification provides that client application 28 disables access to the invoked URL/code. For example, moving the mouse arrow over the coupon/ad does not cause the URL to be displayed, nor is "right-button clicking" operative to allow capture of the URL. Accordingly, *the specified URL (and code) is neither displayed nor available*, and

cannot be discovered by, for example, "right-clicking" on coupon display 76, like conventional web-based e-coupon distribution systems.

VI. Issues

The issues presented for consideration in this appeal are as follows:

Whether the Examiner erred in rejecting claims 24 and 25 under 35 U.S.C. §103 as being allegedly being obvious over U.S. Patent 6,385,591 to Mankoff in view of "*Promotion Profile*", Marketing & Media Decisions, Vol. 24, No. 10, October 1989, p. 103 (Sutherland) and U.S. Patent 6,298,446, Schreiber et al. (Schreiber).

Whether the Examiner erred in rejecting claims 1-6, 9-18, 22 and 23 under 35 U.S.C. §103 as being allegedly being obvious over "Emaginet Plans To 'Push' Its Way Into Consumer Mindset, Pocketbook," Interactive Marketing News, v4, n22, May 30, 1997 (Emaginet).

Whether the Examiner erred in rejecting claims 7 and 8 under 35 U.S.C. §103 as being allegedly being obvious over Mankoff in view of Sutherland and Schreiber, in view of Emaginet, and in further view of U.S. Patent No. 6,006,269 issued to

Phaal.

Whether the Examiner erred in rejecting claim 26 under 35 U.S.C. §102 and being anticipated by, or, in the alternative, under 35 U.S.C. §103 as being allegedly being obvious over Emaginet.

Whether the Examiner erred in rejecting claims 27-31, 34-43 and 44-46 under 35 U.S.C. §103 as being allegedly being obvious over Emaginet.

Whether the Examiner erred in rejecting claims 32-33 under 35 U.S.C. §103 as being allegedly being obvious over Emaginet in view of Phaal.

These issues will be discussed hereinbelow.

VII. Grouping of Claims

For purposes of the issues presented by this appeal:

Claims 1, 3-18, 22-23 stand or fall together.

Claim 2 stands or falls separately.

Claims 24-25 stand or fall together.

Claims 26, 28-44 stand or fall together.

Claims 27, 45-46 stand or fall together.

The arguments set forth in the following section provide reasons why these groups are considered patentable, 37 C.F.R. §1.192 (c)(7).

VIII. Arguments

In the non-final Office Action of July 31, 2003:

The Examiner rejected claims 24 and 25 under 35 U.S.C. §103 as being allegedly being obvious over U.S. Patent 6,385,591 to Mankoff in view of "*Promotion Profile*", Marketing & Media Decisions, Vol. 24, No. 10, October 1989, p. 103 (Sutherland) and U.S. Patent 6,298,446, Schreiber et al. (Schreiber).

The Examiner rejected claims 1-6, 9-18, 22 and 23 under 35 U.S.C. §103 as being allegedly being obvious over "Emaginet Plans To 'Push' Its Way Into Consumer Mindset, Pocketbook," Interactive Marketing News, v4, n22, May 30, 1997 (Emaginet).

The Examiner rejected claims 7 and 8 under 35 U.S.C. §103 as being allegedly being obvious over Mankoff in view of Sutherland and Schreiber, in view of Emaginet, and in further view of U.S. Patent No. 6,006,269 issued to Phaal.

The Examiner rejected claim 26 under 35 U.S.C. §102 and

being anticipated by, or, in the alternative, under 35

U.S.C. §103 as being allegedly being obvious over Emaginet.

The Examiner rejected claims 27-31, 34-43 and 44-46 under 35

U.S.C. §103 as being allegedly being obvious over Emaginet.

The Examiner rejected claims 32-33 under 35 U.S.C. §103 as

being allegedly being obvious over Emaginet in view of

Phaal.

For at least the following reasons, Appellant submits that

these rejections are both technically and legally unsound and

should therefore be reversed.

General Matters

M.P.E.P. 707.07(f) states that "the importance of answering

such arguments is illustrated by *In re Herrmann*, 261 F.2d 598,

120 USPQ 182 (CCPA 1958) where the applicant urged that the

subject matter claimed produced new and useful results. The court

noted that since applicant's statement of advantages was not

questioned by the examiner or the Board of Appeals, it was

constrained to accept the statement at face value and therefore

found certain claims to be allowable. See also *In re Soni*, 54

F.3d 746, 751, 34 USPQ2d 1684, 1688 (Fed Cir. 1995) (Office

failed to rebut applicant's argument)."

Anticipation

"A claim is anticipated only if each and every element as

set forth in the claim is found, either expressly or inherently

described, in a single prior art reference." *Verdegaal Bros. v.*

Union Oil Co. of California, 2 USPQ2d 1051, 1053 (Fed. Cir.

1987).

Obviousness

"The Patent and Trademark Office (PTO) has the burden of

showing a prima facie case of obviousness." *In re Bell*, 26 USPQ2d

1529, 1530 (Fed. Cir. 1993). "In determining the propriety of the

Patent Office case for prima facie obviousness, it is necessary

to ascertain whether the prior art teachings would appear to be

sufficient to one of ordinary skill in the art to suggest making

the proposed substitution or other modification." *In re Taborsky*,

183 USPQ 50, 55 (CCPA 1974). Moreover, *prima facie* obviousness of

a claimed invention is established "only by showing some

objective teaching in the prior art or that knowledge generally

available to one of ordinary skill in the art would lead that

individual to combine the relevant teachings of the references."

In re Fine, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

THE EXAMINER ERRED IN REJECTING CLAIMS 24 AND 25 UNDER 35 U.S.C. §103 AS BEING ALLEGEDLY BEING OBVIOUS OVER MANKOFF IN VIEW OF SUTHERLAND AND SCHREIBER.

This rejection is traversed at least for the following reasons.

Claims 24-25

Independent claim 24 in its current form is as originally filed. Please note that _claim 24 had been **PREVIOUSLY ALLOWED** by the Examiner_ within **the first non-final Office Action** of Paper No. 9, mailed on March 6, 2002, **the first Final Office Action** of Paper No. 13, mailed on April 26, 2002, and **the second non-final Office Action** of Paper No. 16 that withdrew the first Final Office Action, of August 6, 2002. Yet, **the third non-final Office Action** of Paper No. 18, mailed on November 18, 2002 and **the second Final Office Action** of Paper No. 23, mailed on February 11, 2003 include a rejection of claim 24, _although no amendment has been made to that claim._ It was only the filing of the Request for Reconsideration of September 26, 2002 as a potentially dispositive paper that a rejection of claim 24 had been made.

Also note that the non-final Office Action of July 31, 2003 is the **sixth Office Action** made within the above-identified

application, resulting in prosecution delays.

Claim 24 is drawn to a method of secure electronic coupon distribution that includes the steps of associating a Uniform Resource Locator (URL) including a promotional code with a coupon; displaying the coupon to a user; disabling access to the URL by the user; and invoking the URL with a browser to thereby enable the user to redeem the coupon. Specifically, page 17, lines 21-28 of the specification provides that:

> Client application 28 disables access to the invoked URL/code. For example, moving the mouse arrow over the coupon/ad does not cause the URL to be displayed, nor is "right-button clicking" operative to allow capture of the URL. Accordingly, *the specified URL (and code) is neither displayed nor available*, and cannot be discovered by, for example, "right-clicking" on coupon display 76, like conventional web-based e-coupon distribution systems.

Arguably, and at best, column 1, lines 28-35 of Mankoff teaches that it is known in the art to display product or service coupons on pages that are available through the Internet's World Wide Web information retrieval system. A user of a computer may access those pages through use of a conventional Web browser. The user navigates to a given page, which is then saved to a file or

printed. The hard copy of the coupon may then be carried by the user directly to a retail location and used to receive a discount on a given purchase.

Mankoff arguably provides that an electronic or "virtual" coupon is obtained when a user selects a given link in a Web page being displayed on a client machine (column 1, lines 44-47).

Arguably, column 1, lines 50-58 of Mankoff teaches contact information associated with the coupon provider (e.g., address, web site URL, map and e-mail information) as automatically written to the PDA contact file.

Mankoff, at column 2, lines 61-65, arguably teaches that the web server supports files (collectively referred to as a web site) in the form of hypertext documents and objects, and that a network path to a server is identified by a so-called Uniform Resource Locator (URL).

Mankoff, at column 5, lines 3-6, arguably teaches that the banner advertisement offers the consumer a free coupon for the product the consumer wants, preferably by clicking the banner.

In spite of the teachings within Mankoff, that reference fails to disclose, teach or suggest the claimed feature of

<u>disabling access *to the URL* by the user</u>.

The Office Action <u>admits</u> that disabling access to the URL by the user is <u>absent within Mankoff</u>.

Yet, the Office Action contends that column 3, lines 27-33 of Mankoff suggests sending substitute data for requested image data that is protected "reads on" disabling access to the URL by the user.

But note that *<u>column 3, lines 27-33, of Mankoff fails to suggest sending substitute data for requested image data that is protected so that it cannot meet the requirement of "reads on" disabling access to the URL by the user, as contended within the Office Action</u>*.

Instead, column 3, lines 27-33 of Mankoff merely provides that "representative PDA devices include a x86-, PowerPC®- or RISC-based processor, a realtime operating system such as WindRiver VXWorks™, QSSL QNXNeutrino™, PalmOS, or Microsoft Windows CE, a Web browser or other graphics viewer, device drivers, control software, and a modem. These devices also include non-volatile memory, as well as system memory (namely, RAM)."

Thus, column 3, lines 27-33 of Mankoff fails to disclose, teach or suggest that sending substitute data for requested image data that is protected "reads on" disabling access to the URL by the user, contrary to the finding of the Examiner.

As shown hereinabove, *there is **nothing within Mankoff** that discloses, teaches or suggests the claimed feature of disabling access **to the URL** by the user*.

Sutherland arguably makes a reference to "electronic coupon scanning." Nevertheless, Sutherland is silent as to the claimed feature of disabling access to the URL by the user.

The Office Action cites Schreiber for the features deficient within Mankoff. Schreiber arguably teaches a method and system for copyright protection of digital images. Schreiber arguably teaches that SafeMedia includes enhanced system control for preventing screen capture by disabling a clipboard (column 2, lines 27-30).

However, the use of Schreiber is inconsistent with Mankoff for the following reasons.

Whereas the virtual coupon of Mankoff *is saved to a file on a client machine* (Mankoff at column 1, lines 50-51), Schreiber

conversely provides a method and system for <u>enabling a user to</u> <u>view protected image data using his web browser</u> ***without being*** ***able to copy it*** (Schreiber at column 3, lines 2-4).

In this regard, the invention Schreiber is distinct from Mankoff in several respects. A first distinction is that *the* *Schreiber* arguably *displays an image to a user **without*** ***downloading unmodified image data to the user's computer*** (Schreiber at column 3, lines 8-10). A second distinction is that Schreiber arguably prevents a user from copying a protected image both from within and from without his web browser (Schreiber at column 3, lines 15-17). But as noted hereinabove, the virtual coupon of Mankoff is, conversely, ***saved to a file on a client*** ***machine*** (Mankoff at column 1, lines 50-51).

Thus, the skilled artisan would not have applied Schreiber for the features deficient within Mankoff.

In addition, Schreiber arguably teaches that SafeMedia also includes enhanced system control for preventing screen capture by <u>disabling a clipboard</u> (Schreiber at column 2, lines 27-29).

Schreiber arguably teaches that that other prior art techniques for protecting digital images use Java applets within web browsers to <u>disable the menu</u> that pops up when a user right

clicks on a displayed image within his web browser (column 2, lines 37-40).

Schreiber arguably teaches that the <u>disablement of the user's ability to save an image</u> being displayed and the non-enablement of the user to save image data (column 7, lines 19-21 and lines 58-60).

Schreiber arguably teaches that some URL's do not correspond to existing web page files, but instead contain instructions, such as CGI script instructions or Visual Basic instructions, for generating dynamic web pages, such as active server pages. When a user opens such an URL, the server computer typically generates a web page dynamically, and sends the generated web page to the client computer. Column 14, lines 55-61.

Schreiber arguably teaches that in response to a user selecting a URL with a CGI script or such other script, client computer 106 issues an HTTP request to server computer 100 that includes instructions for generating a web page (column 16, lines 6-9).

Schreiber arguably teaches that at step 606 the user opens a URL for an active server page in his web browser, or another such URL that includes a request for dynamically generating a web page

(column 16, line 67 to column 17, line 3).

Schreiber arguably teaches that at step 1002 a user opens a URL for a web page in his web browser (column 21, lines 6-7).

Column 25, lines 34-37 of Schreiber arguably provides for *parameters that are disabled* so that they cannot be edited. They indicate the DLL version of the copyright protection software, the Netscape version and the ActiveX version, respectively.

Also arguably described within Schreiber are the <u>disablement of the DELETE button</u> (column 26, lines 46-47) and the <u>disablement of the REMOVE button</u> (column 27, lines 18-25).

In spite of the above-noted teachings, the claimed feature of ***disabling access to the URL by the user is not found within Schreiber***. Instead, the preferred embodiment of the Schreiber is drawn to a method for protecting <u>digital images</u> distributed over a network (column 3, lines 37-39), and is <u>not drawn to the disablement of access to the URL</u>.

Paragraph 11 of the Office Action ***admits that the references do not teach clicking on the displayed coupon. Yet in paragraph 11, the Office Action contends that a link to a URL is practically always accessed through a click-on image.***

In response to this contention, it is argued that this unsupported contention amounts to nothing more than conclusions that are personal in nature. The teachings, suggestions or incentives supporting the obviousness-type rejection must be clear and particular. ***Broad conclusory statements, standing alone, are not evidence*** (emphasis added). *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Within paragraph 11, the Examiner **believes** that the explanation at column 3, lines 27-33 is so strong that one of ordinary skill in the art would immediately understand that "sending substitute data . . . for requested image data that is protected" means replacing a URL-active image (the requested image data that is protected) with an inactive image (the substitute data) means preventing or disabling access to a URL.

In response to this "belief" by the Examiner, no such disclosure, teaching or suggestion that replacing a URL-active image (the requested image data that is protected) with an inactive image (the substitute data) means preventing or disabling access to a URL is found within the cited prior art.

In this regard, "assertions of technical facts in areas of esoteric technology must always be supported by citation to some

reference work recognized as standard in the pertinent art and the appellant given, in the Patent Office, the opportunity to challenge the correctness of the assertion or the notoriety or repute of the cited reference." (Citations omitted). *In re Pardo and Landau*, 214 USPQ 673, 677 (CCPA 1982). The support must have existed at the time the claimed invention was made. *In re Merck & Co., Inc.*, 231 USPQ 375, 379 (Fed. Cir. 1986).

In addition, "it is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps. The references themselves must provide some teaching whereby the applicant's combination would have been obvious" (citations omitted). *In re Gorman*, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). See also *In re Dembiczak*, 50 USPQ2d 1614, 1616 (Fed. Cir. 1999)(rejection based upon hindsight is reversed).

This assertion amounts to nothing more than an "obvious-to-try" situation. Specifically, "an 'obvious-to-try' situation exists when a general disclosure may pique the scientist's curiosity, such that further investigation might be done as a result of the disclosure, but the disclosure itself does not contain a sufficient teaching of how to obtain the desired result, or that the claimed result would be obtained if certain

directions were pursued." *In re Eli Lilly & Co.*, 14 USPQ2d 1741, 1743 (Fed. Cir. 1990). Moreover, "an invention is 'obvious to try' where the prior art gives either no indication of which parameters are critical or no direction as to which of many possible choices is likely to be successful." *Merck & Co. Inc. v. Biocraft Laboratories Inc.*, 10 USPQ2d 1843, 1845 (Fed. Cir. 1989).

Here, the cited prior art does not contain a sufficient teaching of how to obtain the desired result, or that the claimed result would be obtained if certain directions were pursued. "Obvious to try" is not the standard under §103. *In re O'Farrell*, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988).

The claimed invention includes both disabling access to the URL by the user; and, invoking the URL with a browser to thereby enable the user to redeem the coupon. Yet, the cited prior art fails to disclose, teach or suggest the combination of both disabling access to the URL by the user; and, invoking the URL with a browser to thereby enable the user to redeem the coupon.

THE EXAMINER ERRED IN REJECTING CLAIMS 1-6, 9-18, 22 AND 23 UNDER 35 U.S.C. §103 AS BEING ALLEGEDLY BEING OBVIOUS OVER EMAGINET; and

_THE EXAMINER ERRED IN REJECTING CLAIMS 7 AND 8 UNDER 35
U.S.C. §103 AS BEING ALLEGEDLY BEING OBVIOUS OVER
MANKOFF IN VIEW OF SUTHERLAND AND SCHREIBER, IN VIEW OF
EMAGINET, AND IN FURTHER VIEW OF PHAAL._

Claims 1, 3-18, 22-23

This rejection is traversed at least for the reasons
provided hereinabove in regard to claim 24 and for the following
reasons.

Claim 1 includes the step of collecting device information
from a device of a client system without obtaining information
sufficient to specifically identify the user.

This feature is supported within the specification as
originally filed. For example, figure 4 of the specification as
originally filed depicts step 107. Within that step, personal
information such as the user's name, e-mail address, residence
address, social security number, telephone number, and the like
is not obtained (page 19, lines 34-36). The user ID does not
specifically identify the user personally, but rather, more
accurately associates a physical machine defining client system
14 with user profile information obtained during registration
(page 10, lines 9-12). Significantly, however, the user is not
personally identified nor is it even possible (e.g., through the

"hacking" of server system 12) to identify the user personally, as such information is not even collected from the user (page 10, lines 19-22).

The Office Action admits that this feature is not found within Mankoff, Sutherland and Schreiber, and cites Emaginet for this feature. However, feature is also **not found within Emaginet.**

In particular, Emaginet arguably provides a general discussion regarding electronic coupons. The Final Office Action contends that Emaginet teaches collecting information, which reads on "a device of a client system", without obtaining information sufficient to specifically identify the user, which reads on "device information."

In response to this contention, Emaginet fails to disclose, teach or suggest the step of collecting device information from a device of a client system without obtaining information sufficient to specifically identify the user.

Instead, Emaginet merely proposes, without providing specific details, that customers who register their preferences and buying habits at Emaginet's website can download an assortment of offers. This proposition is far different than a step of collecting device information from a device of a client

system without obtaining information sufficient to specifically identify the user. Thus, Emaginet is silent as to the claimed features noted hereinabove. Moreover, the Office Action fails to show where in Emaginet that this claimed feature can be found.

The Office Action admits that none of the references teach the claimed step of associating a device ID with the device information at a main server system, but contends that they are inherent nevertheless. In particular, the Office Action contends that Emaginet teaches sending offers directly to the user's desktop, which reads on a device, which would necessarily require identification (ID) of the device.

In response to this contention, "the courts *have not* upheld arguments based on 'inherent' properties when there is no supporting teaching in the prior art" (emphasis added). *In re Dillon*, 13 USPQ2d 1337, 1348 (Fed. Cir. 1989). In particular, "a patentable invention, within the ambit of 35 U.S.C. 103 may result even if the inventor has, in effect, merely combined features, old in the art, for their known purpose, without producing anything beyond the results inherent in their use." *In re Sponnoble*, 160 USPQ 237, 243 (CCPA 1969).

Moreover, "the inherency of an advantage and its obviousness are entirely different questions. **That which may be inherent is**

not necessarily known. Obviousness cannot be predicated on what is unknown" (emphasis added). *In re Spormann*, 150 USPQ 449, 452 (CCPA 1966).

In addition, "such a retrospective view of inherency <u>is not a substitute</u> for some teaching or suggestion supporting an obviousness rejection" (emphasis added). *In re Rijckaert*, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

Instead, "when the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, **the PTO *must* produce supporting references** " (emphasis added). *In re Dillon*, at 1348 (Fed. Cir. 1989).

The Examiner must provide rationale or evidence tending to show inherency. See M.P.E.P 2112. In this regard, Emaginet fails to disclose, teach or suggest the details of data transfer between a client and a server sufficient to show the claimed step of associating a device ID with the device information at a main server system.

Emaginet is also is silent as to the claimed feature of disabling access to the URL by the user.

Note that claim 3 includes the step of associating the

device ID with a remote client system. The cited prior art fails to disclose teach or suggest a step of associating the device ID with a remote client system.

In this regard, the Office Action contends, without providing supporting evidence, the step of associating the device ID with a remote client system is found within the cited prior art. However, this unsupported contention amounts to nothing more than conclusions that are personal in nature, which is not evidence of obviousness.

Within claim 6 the request transmitting step includes the step of automatically including the device ID in the request without any intervention by a remote user of the client system.

The cited prior art fails to disclose teach or suggest the request transmitting step that includes the substep of automatically including the device ID in the request without any intervention by a remote user of the client system.

In this regard, the Office Action contends, without providing supporting evidence, that the device ID must be automatically included because there is no other way for the ID to be provided.

However, this unsupported contention amounts to nothing more than conclusions that are personal in nature, which is not evidence of obviousness.

The Office Action cites Phaal for additional features deficient within Mankoff, Sutherland, Schreiber, and Emaginet. However, Phaal arguably teaches an admission control system that includes a buffer for storing a URL (column 7, lines 15-16). Nevertheless, Phaal fails to disclose, teach or suggest the claimed feature of disabling access to the URL by the user.

Claim 2

This rejection is traversed at least for the reasons provided hereinabove in regard to claim 1 and for the following reasons.

Claim 2 includes the substep of obtaining from the remote user demographic characteristics including at least one of a postal zip code associated with the user and a state in which the user resides.

The cited prior art fails to disclose teach or suggest a step of obtaining from the remote user demographic characteristics including at least one of a postal zip code associated with the user and a state in which the user resides.

In this regard, the Office Action contends, without providing supporting evidence, that the demographic characteristics include the user's postal zip code or state of residence.

However, this unsupported contention amounts to nothing more than conclusions that are personal in nature, which is not evidence of obviousness.

THE EXAMINER ERRED IN REJECTING CLAIM 26 UNDER 35 U.S.C. §102 AND BEING ANTICIPATED BY, OR, IN THE ALTERNATIVE, UNDER 35 U.S.C. §103 AS BEING ALLEGEDLY BEING OBVIOUS OVER EMAGINET; and

THE EXAMINER ERRED IN REJECTING CLAIMS 27-31, 34-43 AND 44-46 UNDER 35 U.S.C. §103 AS BEING ALLEGEDLY BEING OBVIOUS OVER EMAGINET; and

THE EXAMINER ERRED IN REJECTING CLAIMS 32-33 UNDER 35 U.S.C. §103 AS BEING ALLEGEDLY BEING OBVIOUS OVER EMAGINET IN VIEW OF PHAAL.

Claims 26, 28-44

This rejection is traversed at for the following reasons.

The claims include the step of collecting device information from a device of a client system without obtaining information sufficient to specifically identify the user.

This feature is supported within the specification as originally filed. For example, figure 4 of the specification as originally filed depicts step 107. Within that step, personal information such as the user's name, e-mail address, residence address, social security number, telephone number, and the like is not obtained (page 19, lines 34-36). The user ID does not specifically identify the user personally, but rather, more accurately associates a physical machine defining client system 14 with user profile information obtained during registration (page 10, lines 9-12). Significantly, however, the user is not personally identified nor is it even possible (e.g., through the "hacking" of server system 12) to identify the user personally, as such information is not even collected from the user (page 10, lines 19-22).

The Office Action admits that this feature is not found within Mankoff, Sutherland and Schreiber, and cites Emaginet for this feature. However, feature is also **not found within Emaginet.**

In particular, Emaginet arguably provides a general

discussion regarding electronic coupons. The Office Action contends that Emaginet teaches collecting information, which reads on "a device of a client system", without obtaining information sufficient to specifically identify the user, which reads on "device information."

In response to this contention, Emaginet fails to disclose, teach or suggest the step of collecting device information from a device of a client system without obtaining information sufficient to specifically identify the user.

Instead, Emaginet merely proposes, without providing specific details, that customers who register their preferences and buying habits at Emaginet's website can download an assortment of offers. This proposition is far different than a step of collecting device information from a device of a client system without obtaining information sufficient to specifically identify the user. Thus, Emaginet is silent as to the claimed features noted hereinabove. Moreover, the Office Action fails to show where in Emaginet that this claimed feature can be found.

The Office Action admits that none of the references teach the claimed step of associating a device ID with the device information at a main server system, but contends that they are inherent nevertheless. In particular, the Office Action contends

that Emaginet teaches sending offers directly to the user's desktop, which reads on a device, which would necessarily require identification (ID) of the device.

In response to this contention, "the courts *have not* upheld arguments based on 'inherent' properties when there is no supporting teaching in the prior art" (emphasis added). *In re Dillon*, 13 USPQ2d 1337, 1348 (Fed. Cir. 1989). In particular, "a patentable invention, within the ambit of 35 U.S.C. 103 may result even if the inventor has, in effect, merely combined features, old in the art, for their known purpose, without producing anything beyond the results inherent in their use." *In re Sponnoble*, 160 USPQ 237, 243 (CCPA 1969).

Moreover, "the inherency of an advantage and its obviousness are entirely different questions. **That which may be inherent is not necessarily known**. Obviousness cannot be predicated on what is unknown" (emphasis added). *In re Spormann*, 150 USPQ 449, 452 (CCPA 1966).

In addition, "such a retrospective view of inherency <u>is not a substitute</u> for some teaching or suggestion supporting an obviousness rejection" (emphasis added). *In re Rijckaert*, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

Instead, "when the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, **the PTO _must_ _produce supporting references_** " (emphasis added). *In re Dillon*, at 1348 (Fed. Cir. 1989).

The Examiner must provide rationale or evidence tending to show inherency. See M.P.E.P 2112. In this regard, Emaginet fails to disclose, teach or suggest the details of data transfer between a client and a server sufficient to show the claimed step of associating a device ID with the device information at a main server system.

Emaginet is also is silent as to the claimed feature of disabling access to the URL by the user.

Note that claim 29 includes the step of associating the device ID with a remote client system. The cited prior art fails to disclose teach or suggest a step of associating the device ID with a remote client system.

In this regard, the Office Action contends, without providing supporting evidence, the step of associating the device ID with a remote client system is found within the cited prior art. However, this unsupported contention amounts to nothing more than conclusions that are personal in nature, which is not

evidence of obviousness.

Within claim 31 the request transmitting step includes the step of automatically including the device ID in the request without any intervention by a remote user of the client system.

The cited prior art fails to disclose teach or suggest the request transmitting step that includes the substep of automatically including the device ID in the request without any intervention by a remote user of the client system.

In this regard, the Office Action contends, without providing supporting evidence, that the device ID must be automatically included because there is no other way for the ID to be provided.

However, this unsupported contention amounts to nothing more than conclusions that are personal in nature, which is not evidence of obviousness.

The Office Action cites Phaal for additional features deficient within Mankoff, Sutherland, Schreiber, and Emaginet. However, Phaal arguably teaches an admission control system that includes a buffer for storing a URL (column 7, lines 15-16). Nevertheless, Phaal fails to disclose, teach or suggest the

claimed feature of disabling access to the URL by the user.

Claims 27, 45-46

This rejection is traversed at least for the reasons provided hereinabove in regard to claim 26 and for the following reasons.

The claims include the step of obtaining from the remote user demographic characteristics including at least one of a postal zip code associated with the user and a state in which the user resides.

The cited prior art fails to disclose teach or suggest a step of obtaining from the remote user demographic characteristics including at least one of a postal zip code associated with the user and a state in which the user resides.

In this regard, the Office Action contends, without providing supporting evidence, that the demographic characteristics include the user's postal zip code or state of residence.

However, this unsupported contention amounts to nothing more than conclusions that are personal in nature, which is not evidence of obviousness.
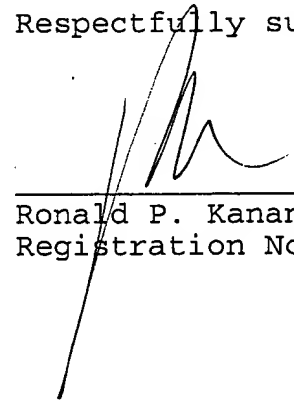
Conclusion

The cited prior art fails to disclose, teach or suggest all the features of claims 1-18 and 22-46. Thus, the claims are considered allowable for the reasons discussed above, as well as for the additional features they recite. In view of the above, the rejection of claims 1-18 and 22-46 is improper and should not be sustained. Therefore, a reversal of the non-final rejection of July 31, 2003 as to claims 1-18 and 22-46 is respectfully requested.

Respectfully submitted,

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IX. APPENDIX

Claims on Appeal

1. The method of claim 24 further including the steps of:

collecting device information from a device of a client system without obtaining information sufficient to specifically identify the user;

associating a device ID with the device information at a main server system;

selecting said coupon according to the device ID to thereby identify the coupon appropriate for said user based on the device information; and,

transmitting the selected coupon from the main server system to the client system.

2. The method of claim 1 wherein said collecting step comprises the optional substep of:

obtaining from the remote user demographic characteristics including at least one of a postal zip code associated with the user and a state in which the user resides.

3. The method of claim 1 further including the step of:

associating the device ID with a remote client system.

4. The method of claim 3 further including the step of:

generating a printed version of one of the transmitted

coupon at the remote client system.

5. The method of claim 3 further including the step of:

transmitting a request from the client system to the server

system to perform said selecting step wherein the request

includes the device ID.

6. The method of claim 5 wherein said request transmitting

step includes the substep of:

automatically including the device ID in the request without

any intervention by a remote user of the client system.

7. The method of claim 5 wherein said request transmitting

step occurs automatically without any intervention by a remote

user.

8. The method of claim 7 wherein said request transmitting

step occurs at predetermined intervals.

9. The method of claim 3 wherein the remote client system

operates in accordance with an operating system characterized by

a graphical user interface (GUI), said method further including

the steps of:

displaying an icon visible to the user in a first display state; and,

displaying the icon in a second display state different from the first display state when a new coupon is available for the user.

10. The method of claim 9 wherein the second display state is a flashing display state.

11. The method of claim 3 wherein said transmitting step includes the substeps of:

encrypting coupon data corresponding to the selected coupon at the server system in accordance with a server system encryption strategy; and,

sending the server-encrypted coupon data to the client system.

12. The method of claim 11 further including the step of:

receiving the server-encrypted coupon data at the client system;

encrypting the server-encrypted coupon data in accordance with a client system encryption strategy to thereby generate doubly-encrypted coupon data; and,

storing the doubly-encrypted coupon data on the client system.

13. The method of claim 12 further including the steps of:

decrypting the doubly-encrypted coupon data at the client system; and,

generating a printed version of one of the selected coupon at the remote client system.

14. The method of claim 3 further comprising the steps of:

transmitting advertising data to the client system; and,

displaying at least a portion of the transmitted advertising data on a display portion of the remote client system.

15. The method of claim 14 wherein the advertising data comprises a plurality of advertising impressions, and, wherein said displaying step comprises the substep of:

selecting one of the plurality of advertising impressions as a function of a selected subcategory of coupons available on the remote client system.

16. The method of claim 3 further comprising the steps of:

detecting events occurring at the remote client system;

storing the detected events in a user history file; and,

transmitting the user history file to the server system.

17. The method of claim 16 wherein said detecting step

includes the substeps of:

determining when one of a plurality of advertising impressions has been displayed on a display portion of the remote client system; and,

determining a sponsor identification of the advertising impression.

18.   The method of claim 16 wherein the storing step comprises the substep of:

encrypting the detected events to thereby generate encrypted user event information; and,

writing the encrypted user event information to the client system.

22. The method of claim 24 further including the steps of:

collecting device information from a device on a network;

associating a device ID with the device information;

selecting said coupon according to the device ID;

encrypting coupon data corresponding to the selected coupon; and,

transmitting the encrypted coupon data from the main server system to the client system.

23. The method of claim 22 further including the step of:

decrypting the encrypted coupon data to recover the selected

coupon.

24. A method of secure electronic coupon distribution
comprising the steps of:

associating a Uniform Resource Locator (URL) including a
promotional code with a coupon;

displaying the coupon to a user;

disabling access to the URL by the user; and,

invoking the URL with a browser to thereby enable the user
to redeem the coupon.

25. The method of claim 24 wherein said invoking step
includes the substep of selecting the coupon by one of clicking
on the displayed coupon and clicking on an object different than
the coupon displayed to the user.

26. A method of operating an electronic coupon distribution
system comprising the steps of:

collecting device information from a device of a client
system without obtaining information sufficient to specifically
identify the user;

associating a device ID with the device information at a
main server system;

selecting a coupon according to the device ID to thereby
identify the coupon appropriate for said user based on the device

information; and,

transmitting the selected coupon from the main server system to the client system.

27. The method of claim 26 wherein said collecting step comprises the substep of:

obtaining from the remote user demographic characteristics including at least one of a postal zip code associated with the user and a state in which the user resides.

28. The method of claim 26 further including the step of:

associating the device ID with a remote client system.

29. The method of claim 28 further including the step of:

generating a printed version of one of the transmitted coupons at the remote client system that includes the device ID.

30. The method of claim 28 further including the step of:

transmitting a request from the client system to the server system to perform said selecting step wherein the request includes the device ID.

31. The method of claim 30 wherein said request transmitting step includes the substep of:

automatically including the device ID in the request without

any intervention by the remote user of the client system.

32. The method of claim 30 wherein said request transmitting step occurs automatically without any intervention by the remote user.

33. The method of claim 32 wherein said request transmitting step occurs at predetermined intervals.

34. The method of claim 28 wherein the remote client system operates in accordance with an operating system characterized by a graphical user interface (GUI), said method further including the steps of:

displaying an icon visible to the user in a first display state; and,

displaying the icon in a second display state different from the first display state when new coupon are available for the user.

35. The method of claim 34 wherein the second display state is a flashing display state.

36. The method of claim 28 wherein said transmitting step includes the substeps of:

encrypting coupon data corresponding to the selected coupons

at the server system in accordance with a server system encryption strategy; and,

sending the server-encrypted coupon data to the client system.

37. The method of claim 36 further including the step of:

receiving the server-encrypted coupon data at the client system;

encrypting the server-encrypted coupon data in accordance with a client system encryption strategy to thereby generate doubly-encrypted coupon data; and,

storing the doubly-encrypted coupon data on the client system.

38. The method of claim 37 further including the steps of:

decrypting the doubly-encrypted coupon data at the client system; and,

generating a printed version of one of the selected coupons at the remote client system.

39. The method of claim 28 further comprising the steps of:

transmitting advertising data to the client system; and,

displaying at least a portion of the transmitted advertising data on a display portion of the remote client system.

40. The method of claim 39 wherein the advertising data comprises a plurality of advertising impressions, and, wherein said displaying step comprises the substep of:

selecting one of the plurality of advertising impressions as a function of a selected subcategory of coupons available on the remote client system.

41. The method of claim 28 further comprising the steps of:

detecting events occurring at the remote client system;

storing the detected events in a user history file; and,

transmitting the user history file to the server system.

42. The method of claim 41 wherein said detecting step includes the substeps of:

determining when one of a plurality of advertising impressions has been displayed on a display portion of the remote client system; and,

determining a sponsor identification of the advertising impression.

43. The method of claim 41 wherein the storing step comprises the substep of:

encrypting the detected events to thereby generate encrypted user event information; and,

writing the encrypted user event information to the client

system.

44. A coupon distribution system, comprising:

means for collecting device information from a user of a remote client system indicative of one or more demographic characteristics of the user without obtaining information sufficient to specifically identify the user;

means for associating a device ID with the device information at a main server system;

means for selecting coupons according to the device ID to thereby identify coupons appropriate for the user based on the user's demographic characteristics; and,

means for transmitting the selected coupons from the server system to the client system.

45. The system of claim 44 wherein said collecting means includes means for obtaining from the remote user demographic characteristics including at least one of a postal zip code associated with the user and a state in which the user resides.

46. The system of claim 45 further including means for associating the device ID with the remote client system.